

## REMARKS

Claims 1 - 15 remain active in this application. The specification has again been reviewed and editorial revisions made where seen to be appropriate. Claims 1 and 6 have been amended to emphasize novel and distinguishing features of the invention. Support for the amendments of the claims is found throughout the application, particularly on page 13 of the specification as originally filed. No new matter has been introduced into the application. The withdrawal of the previous grounds of rejection is noted with appreciation.

Claims 1 - 2, 6 - 8 and 15 have been rejected under 35 U.S.C. §102 as being anticipated by Carter et al.; claims 3 - 5 have been rejected under 35 U.S.C. §103 as being unpatentable over Carter et al. in view of Welles, II, et al.; claims 9 - 10 have been rejected under 35 U.S.C. §103 as being unpatentable over Carter et al. in view of Stewart; claim 11 has been rejected under 35 U.S.C. §103 as being unpatentable over Carter et al. in view of Stewart and Raleigh et al.; and claim 12 has been rejected under 35 U.S.C. §103 as being unpatentable over Carter et al. in view of Stewart and Gamlyn et al. All of these grounds of rejection are respectfully traversed.

Initially, it is noted that the present action has been made based upon newly cited prior art after the filing of an Appellant's Brief on Appeal. As will be discussed in detail below, it is Applicants' position that the newly cited prior art fails to answer the invention as defined in the claims in much the same manner as the previously applied prior art (e.g. Bolavage et al.) and previously submitted remarks and arguments in the Appeal Brief are hereby incorporated by reference. It is respectfully submitted to be prejudicial to Applicant to re-open prosecution after

adhering to a clearly improper ground of rejection necessitating the filing of an Appeal Brief while continuing to fail to address basic distinguishing features of the invention recited in the claims and construing the newly applied reference through impermissible hindsight. Additionally, the above amendments and the following remarks are made without prejudice to the Applicants' right to demonstrate prior invention in regard to Carter et al. under 37 C.F.R. §1.131.

As pointed out in previously submitted remarks summarized in the Appeal Brief,

"The invention, as claimed, is a transducer capable of communicating with an access point of a digital communication network (claims 1 - 5 and 15) and an asset tracking system (claims 6 - 14) including a transponder, a digital communication network and means for reporting internal network access point information in association with identification information provided from the transponder to the access point. In both sets of claims, the access points are explicitly defined as being part of a "standard digital network" (claim 1, emphasis added) or that the computer network supports "a plurality of wireless links from respective *wireless access points of said computer network*" (claim 6, emphasis added). Therefore, the claims specifically and explicitly refer to the wireless access points as being a part of the digital communications network."

In other words, the approach to the problem of asset tracking in accordance with the invention as claimed allows the additional functions of asset tracking and further functionality of integrating the asset tracking

with other network communication and reporting functions *without hardware modifications of the wireless network infrastructure.*

Carter et al., in contrast, seeks to obtain a somewhat similar system capability through a much different approach: modifying *some* access points (see Abstract) to include a substantially standard RFID system operating in parallel with but otherwise functionally separate from a wireless portion of a computer network. More specifically, Carter et al. provides that the access points may include *either* a multi-band or single band access point (the multi-band access points having a capability of communicating realtime information such as patient telemetry as well as communicating with processors or terminals over wireless links, as is done over single band access points. Carter et al. additionally teaches that "[S]ome or all of the access points *may* also include RF location-tracking *modules* which may be used to track locations of patients, hospital personnel, capital equipment..." (Abstract, *emphasis added*), clearly a hardware modification of the network infrastructure.

This basic distinction of the invention is particularly clear from page 13 of the present specification and Figure 1 of Carter et al., which the Examiner is respectfully invited to compare. Page 13 of the specification indicates that transponders which communicate using a wireless network communication protocol (and which, at the present state of the art must be active) allow the invention to be implemented in software at the network level without hardware infrastructure modification although different transponders capable of communication using a wireless network protocol would be required. Carter et al. teaches *what is disclosed in the present application* to be a diametrically opposite approach: modification of the hardware infrastructure to detect (e.g. *standard*)

RFID tags. This is abundantly apparent from Figure 1 of Carter et al. which illustrates a location-tracing receiver/module 49A included within multi-band or single band access points. The RFID function is disclosed in Carter et al. to preferably be performed over an ISM band separate from the wireless network communication links (see column 5, lines 10 - 14 and column 6, line 35). The hardware infrastructure modifications required by Carter et al. are extensive (see column 7, line 39 to column 9, line 7) and the RFID portion of the system is clearly "closed" since additional RFID modules must be added to access points as needed to configure the system for that function at desired locations as may be "updated over time" (see column 8, lines 3 - 8). Therefore, it is clear that Carter et al. does not answer such claim recitations (as currently rejected) as "means for transmitting a signal *that can be received by an access point of said standard data network and interpreted by an access point of said standard data network* as identification information" (claim 1, emphasis added) or "a transponder *detectable by said wireless access points of said computer network*" (claim 6, emphasis added). Carter et al. merely provide for installation of RFID system hardware in wireless network access points but does not teach or suggest detection of and/or communication with RFID transponders *through the wireless network communication links* in order to achieve an open and expandable system as well as integration of RFID functions with other network communications functions such as condition reporting and remote control. Carter et al. clearly provides location tracking in a manner entirely separate from any telemetry function and thus does not facilitate, for example, condition or operational state reporting of the tracked assets as provided by the present invention, as claimed.

It is recognized (but not acquiesced in) that once Carter et al. has been construed, through, it is respectfully submitted, impermissible hindsight not only in view of but contrary to the present disclosure, as providing RFID communications *through* a wireless network access point, it is arguable that the transponders of the system of Carter et al. can be detected by an access point. However, such an improper construction and, hence, argument glosses over the basic difference in approach to the problem discussed above. Simply put, Carter et al. provides for hardware infrastructure to be substantially modified at substantial cost (although such hardware modifications are slightly facilitated by such features as sockets 50, 52) so that standard RFID tags may be used while the invention provides for avoidance of such hardware infrastructure modifications by using transponders capable of communicating through existing and standard wireless network access points. Therefore, while it is believed that the claims, as currently rejected, are not answered by Carter et al., claims 1 and 6 have been amended to recite that the communications with the transponders are performed "in accordance with a wireless network protocol" which Carter et al. clearly does not teach or suggest and from which Carter et al. clearly teaches away.

The newly cited and applied reference to Stewart et al. does not mitigate this basic deficiency of Carter et al. to answer the recitations of the claims. The Examiner (incorrectly) indicates that Carter et al. does not teach or suggest means for determining proximity of a transponder to an access point and cites Stewart et al for this limited teaching. In fact, Carter et al. mentions use of received signal strength indicator (RSSI) signals for location determination in connection with use of a "chirper" and a separate signaling band at column 6, lines 23 - 51; a *discussion*

*of either of which would highlight the Examiner's error in construction and application of Carter et al. in regard to the independent claims, while Stewart et al. is directed to providing geographically relevant information to a mobile terminal in accordance with active access point identification and does not involve transponders or asset tracking in any way, much less in the manner claimed. Similarly, as pointed out in previously submitted remarks, the Welles, II, et al., Raleigh et al. and Gamlyn et al. references, taken separately or together with Carter et al. and/or Stewart et al. in any combination do not mitigate the basic deficiency of Carter et al. to answer the recitations of any claim in the application, as discussed above.*

Further, it is respectfully submitted that the error in construction and application of Carter et al. is substantially the same as the error in the Examiner's prior application of Bolavage et al. That is, as previously and persuasively pointed out, Bolavage et al. like Carter et al. is directed to an arrangement which allows detection of or radio reception from standard RFID tags through hardware infrastructure modification rather than providing transponders which can communicate with a network through standard wireless access points. Accordingly, it is respectfully submitted that, but for the physical location of RFID hardware in the physical structure of a wireless access point, Carter et al. is no more relevant than Bolavage et al, now overcome, while the advantages of the invention over systems of the type of Carter et al. are explicitly discussed in the specification as originally filed and which the Examiner continues to inadequately understand or ignore.

Therefore, it is clear that all of the grounds of rejection noted above are clearly in error for reasons

basically very similar to those previously and persuasively addressed in regard to Bolavage et al. In short, Carter et al. simply does not contain the teachings or suggestions the Examiner attributes to it and approaches asset tracking in a manner diametrically opposed to that of the invention, as reflected in the claims as rejected and emphasized in the above amendments. Therefore, Carter et al. does not anticipate any claim in the application and cannot properly be modified to answer the claim recitations without precluding the intended function thereof (see *In re Gordon*, 221 USPQ 1125 (Fed. Circ., 1984) since function supported by the claimed subject matter and the function of Carter et al. are mutually exclusive: the invention avoiding hardware modifications by use of a differently functioning transponder while Carter et al. *relies* upon hardware modifications to accommodate existing transponders. Further, Carter et al. taken alone or in any combination with other references of record does not provide evidence of a level of ordinary skill in the art which would support a conclusion of obviousness in regard to any claim in the application since the teaching thereof do not lead to an expectation of success in providing the meritorious functions and advantages of the invention. In this regard, it should be appreciated that the invention, while using a novel type of transponder, provides substantial economic advantages (in addition to the advantage of the system being "open" and readily expandable as well as in facilitating the integration of asset tracking and condition reporting with other network functions) over a system such as that of Carter et al. as the network and number of tracked assets become large since the cost differential between types of transponders is relatively small and no modification of access point architecture is required in accordance with the invention.

Moreover, by continuing to fail to recognize the very basic distinction of the invention over the prior art in regard to Carter et al. which has been persuasively demonstrated in regard to Bolavage et al., the Examiner has failed to make a *prima facie* demonstration of anticipation or obviousness of any claim in the application in regard to the Examiner's reliance on Carter et al. Rather, the Examiner has not only improperly construed Carter et al. but has done so through impermissible hindsight in view of the present disclosure. Accordingly, it is respectfully submitted that all of the asserted grounds of rejection are untenable and reconsideration and withdrawal thereof are respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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